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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,009	01/08/2004	Manabu Matsubara	51766/DBP/A400	7159
23363 7590 03/20/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER KAPLAN, HAL IRA	
			ART UNIT	PAPER NUMBER
			2836	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/754,009

Applicant(s)

MATSUBARA ET AL.

Examiner

Hal I. Kaplan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6 and 11 is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 12 is/are rejected.
- 7) ☒ Claim(s) 5 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings were received on January 19, 2007. These drawings are accepted.

Claim Objections

2. Claims 5 and 7 are objected to because of the following informalities: Claim 5, line 12 contains the phrase "IG key not being inserted". It appears this should be "IG key is not inserted". Claim 7, line 7 contains the phrase "by an IG key". It appears this should be "from an IG key". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the US patent of Hayashi et al. (5,912,512) in view of the US patent of Tado et al. (5,973,411).

As to claim 7, Hayashi, drawn to an engine start control apparatus, discloses a remote control engine starting device, wherein an immobilizer (12) comprises an interrogating signal outputting section which outputs an interrogating signal (TXCT) to the remote engine starter (54) upon receiving an engine starting signal (KWS-on-signal) from the remote engine starter (54), and an engine start permitting section which outputs an engine start permitting signal, wherein a remote engine starter (54) comprises an engine start signal outputting section (70) which outputs an engine starting signal and a code outputting section (70) which outputs a remote engine starter code (CODE) preregistered in the remote engine starter (54) in response to an interrogating signal (TXCT) which is output from the immobilizer (12), wherein the immobilizer (12) outputs the interrogating signal (TXCT) upon receiving the engine starting signal, and determines whether or not the remote engine starter code (CODE) matches a preregistered code in the immobilizer (12), when the immobilizer (12)

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receives a remote engine starter code output in response to the interrogating signal (TXCT), and wherein the engine start permitting section outputs an engine start permitting signal when the remote engine starter code (CODE) matches the preregistered code in the immobilizer (12) (see column 9, lines 3-5 and 24-28). Hayashi does not disclose:

- (a) an activation signal outputting section; and
- (b) a determination whether or not a key code matches a preregistered code in the immobilizer upon receiving a key code output in response to an activation signal.

Tado, drawn to an apparatus for protecting motor vehicle against unauthorized operation, discloses an immobilizer (3A,5A) comprising an activation signal outputting section which outputs an activation signal to a key cylinder (2) upon receiving an engine starting signal from an IG key (1), and the system of Tado determines whether or not a key code matches a preregistered code in the immobilizer (3A,5A) upon receiving the key code output in response to the activation signal (see column 7, line 66 - column 8, line 44). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Hayashi to include the functionality of Tado, in order to provide additional and more robust theft protection.

As to claim 8, as set forth above, the immobilizer of Hayashi outputs the interrogating signal to the remote engine starter when the immobilizer receives the engine starting signal from the remote engine starter, regardless of whether an IG key insertion signal is received.

As to claim 12, the engine start permitting section of the immobilizer of Tado does not output the engine start permitting signal when the remote engine starter code does not match the preregistered code in the immobilizer (see column 8, lines 45-58).

Allowable Subject Matter

7. Claims 1-4, 6, and 11 allowed.
8. Claim 5 is objected to for an informality but would be allowable if the informality was corrected because it depends from allowed claim 1.
9. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter:

Claim 9 contains allowable subject matter because none of the prior art of record discloses or suggests an immobilizer which outputs an interrogating signal to the remote engine starter when it does not receive key code input in response to an activation signal, in combination with the remaining claimed features.

11. The following is an examiner's statement of reasons for allowance:

Claims 1-6 and 11 are allowed because, as noted by the Applicant, none of the prior art of record discloses or suggests the remote engine starter receiving the interrogating signal for a second time when the remote engine starter code is not output or does not match the remote engine starter verifying code, in combination with the remaining claimed features.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

12. Applicant's arguments, see Remarks, filed January 19, 2007, with respect to the objections and rejections of claims 1-5 and 11 have been fully considered and are persuasive. The objections and rejections of claims 1-5 and 11 have been withdrawn.

13. In the Remarks filed January 19, 2007, the Applicant states that claim 1 includes the limitations "an activation signal outputting section which outputs an activation signal ...". Claim 1 does not include these limitations, and the Examiner has assumed that this was in error and the Applicant was referring to claim 7. Regarding the limitation "immobilizer outputs an activation signal ... in response to said interrogating signal", it is not clear whether both determination steps occur in response to the interrogating signal, or whether only the second determination step occurs in response to the interrogating signal, since the immobilizer outputs both the activation and interrogating signals and thus does not receive them. For purposes of this Office Action, the Examiner has assumed that only the second determination step occurs in response to the interrogating signal, i.e. that the immobilizer outputs the activation and interrogating signals to the IG key and remote engine starter, respectively, then receives key code output from the IG key in response to the activation signal, and a remote engine starter

code from the remote engine starter in response to the interrogating signal, and then determines whether the two codes match their respective preregistered codes.

14. As to claims 7, 8, and 12, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner agrees that Tado does not teach determining whether the remote engine starter code matches a preregistered code in the immobilizer; however, Hayashi teaches this feature, as set forth above.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal I. Kaplan whose telephone number is 571-272-8587. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 571-272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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